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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,861	07/03/2003	Andrew John Thomas	08505.0007-01	3836
22852	7590	04/06/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			WONG, STEVEN B	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/611,861

Applicant(s)

THOMAS, ANDREW JOHN

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-34 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-34 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 19-33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Litchfield. Regarding claims 19, 27 and 36, Litchfield discloses a ball (note Figures 5 and 6) which deviates from an expected trajectory comprising a relatively smooth portion (12) and a rough portion (14). Note column 5, lines 42-45 and Figure 5 which state that a simulated seam may be included. It would have been obvious to one of ordinary skill in the art to provide a plurality of rows of imitation stitches on the ball in order to have the ball imitate a ball used in the game of cricket. It would have been obvious to one of ordinary skill in the art to have the smooth portion cover greater than 50% of the ball in order to alter the flight characteristics of the ball. The limitation for the particular amount of the ball to be covered by the smooth surface (55%-75%) has been determined to be obvious lacking a showing of its criticality by a new and unexpected result. The applicant is invited to submit a showing of the criticality in the form of declaration with test results in order to demonstrate the unobviousness of the limitation over the teachings of Litchfield.

Regarding claims 20, 21, 26, 28 and 30, Litchfield teaches a rough portion comprising a nap material. The examiner takes Official Notice that it is well known in the art of tennis balls to provide an elastomer core and apply a nap material thereto with a flexible adhesive solution.

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Regarding claims 22, 23 and 29, it would have been obvious to one of ordinary skill in the art to form the core of Litchfield from polyurethane or cork in order to take advantage of that material's well known physical characteristics.

Regarding claims 24 and 25, note column 5, lines 40-42 which state that the ball could be hollow or solid.

Regarding claims 31 and 33, Litchfield also teaches an embodiment wherein the ball is formed from the same material and includes a plurality of dimples (18) on the rough surface (12).

Regarding claim 32, note the rejection of claim 22 above.

2. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Litchfield in view of Grechko. Litchfield lacks the teaching for the particular size of the dimples as recited by applicant.

Grechko reveals a baseball construction including a plurality of dimples (16) thereon for influencing the trajectory of the ball. It would have been obvious to one of ordinary skill in the art to form the dimples of Litchfield as circular dimples for the reasons advanced by Grechko. Further, it would have been obvious to one of ordinary skill in the art to form the dimples of Litchfield as modified by Grechko to the claimed dimension as the applicant has not shown that this particular size solves any stated purpose and it appears that the size taught by Grechko would accomplish similar purposes.

3. Claims 19-24, 26-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin (GB 2,314,778). Regarding claims 19, 27 and 36, Griffin discloses a ball comprising a hemisphere having a smooth portion (4) and a seam (5) and a hemisphere having a

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rough portion (2). Note page 2, lines 29-34 stating that a seam can be provided to create deviation like a real cricket ball. It would have been obvious to one of ordinary skill in the art to provide the ball with a plurality of rows of imitation stitches in order for the ball to simulate an official cricket ball and create similar deviation. The smooth portion is seen as covering greater than 50% of the surface of the ball due to the inclusion of both members 4 and 5. In the alternative, it would have been obvious to one of ordinary skill in the art to have the smooth portion cover greater than 50% of the surface of the ball in order to alter the flight characteristics of the ball. The limitation for the particular amount of the ball to be covered by the smooth surface (55%-75%) has been determined to be obvious lacking a showing of its criticality by a new and unexpected result. The applicant is invited to submit a showing of the criticality in the form of a declaration with test results in order to demonstrate the unobviousness of the limitation over the teachings of Litchfield.

Regarding claims 20, 21, 26, 28 and 30, Griffin teaches a rough portion comprising a bristle material as used in tennis balls (pages 1, 37-39). The examiner takes Official Notice that it is well known in the art of tennis balls to provide an elastomer core and apply a nap material thereto with a flexible adhesive solution.

Regarding claims 22, 23 and 29, it would have been obvious to one of ordinary skill in the art to form the core of Griffin from polyurethane or cork in order to take advantage of that material's well known physical characteristics.

Regarding claim 24, note page 3 which states that the ball is hollow.

Regarding claims 31 and 33, Griffin also teaches an embodiment wherein the ball is formed from the same material and includes a plurality of dimples (3) on the rough surface (2).

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Regarding claim 32, note the rejection of claim 22 above.

Regarding claim 34, it would have been obvious to one of ordinary skill in the art to form the dimples of Griffin to the claimed dimensions as the applicant has not shown the criticality for the claimed sizes and it appears that the dimensions taught by Griffin would accomplish similar purposes.

4. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin in view of Litchfield. Litchfield discloses a game ball including a hemisphere having a rough surface and a hemisphere having a relatively smooth surface. Litchfield particularly teaches that it is well known in the art of these balls to provide either hollow or solid center cores (column 5, lines 40-42). It would have been obvious to one of ordinary skill in the art to form the ball of Griffin with either a hollow or solid core for the reasons advanced by Litchfield.

### *Conclusion*

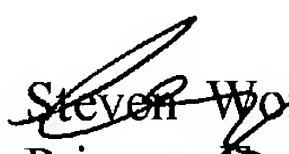
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 703-308-3135. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
April 2, 2004